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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,700	01/15/2004	Sang-Cheol Min	0630-1926P	4491

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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HEFFINGTON, JOHN M

ART UNIT	PAPER NUMBER
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2179

NOTIFICATION DATE	DELIVERY MODE
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02/24/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<i>Office Action Summary</i>	Application No. 10/757,700	Applicant(s) MIN, SANG-CHEOL	
	Examiner JOHN M. HEFFINGTON	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 23-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

This action is in response to request for continued examination dated 4 December 2008. Claims 1-22 have been canceled. Claims 23-36 (after renumbering) are have been added. Claims 23-36 (after renumbering) are pending and have been considered below.

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 December 2008 has been entered.

### *Claim Objections*

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 26-35 been renumbered 27-36.

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The preamble of claim 31 (after renumbering) should be amended to read as follows: The mobile terminal system of claim ~~29~~ 30, ... .

The preamble of claim 32 (after renumbering) should be amended to read as follows: The mobile terminal system of claim ~~29~~ 30, ... .

The preamble of claim 33 (after renumbering) should be amended to read as follows: The mobile terminal system of claim ~~29~~ 30, ... .

The preamble of claim 34 (after renumbering) should be amended to read as follows: The mobile terminal system of claim ~~29~~ 30, ... .

The preamble of claim 35 (after renumbering) should be amended to read as follows: The mobile terminal system of claim ~~29~~ 30, ... .

The preamble of claim 36 (after renumbering) should be amended to read as follows: The mobile terminal system of claim ~~29~~ 30, ... .

*Means Plus Function - 35 USC § 112 6<sup>th</sup> Paragraph*

The following is a quotation of 35 U.S.C. 112 6<sup>th</sup> paragraph which forms the basis for means plus function claims:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

(Amended July 24, 1965, Public Law 89-83, sec. 9, 79 Stat. 261; Nov. 14, 1975, Public Law 94-131, sec. 7, 89 Stat. 691.)

It appears that the applicant is attempting to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph in claim 30 (after renumbering). At page 7, lines 10-15 of the Detailed Description of the

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instant application, a base station for the purposes of establishing a communications connection is disclosed. Therefore, it is the examiner's opinion that the applicant has successfully invoked 35 U.S.C. 112 6<sup>th</sup> paragraph in claiming a communications means.

*Response to Arguments*

3. Applicant's arguments with respect to claims 23 and 30 (after renumbering) have been considered but are moot in view of the new ground(s) of rejection.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 23-26, 28-33, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Traversat et al. (US 2002/0184311 A1) in view of Birkler et al. (US 2002/0069298 A1).

Claims 1-22: (Canceled).

Claim 23: Traversat discloses a method of communication between mobile terminals comprising:

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- a. establishing a communication link between a first mobile terminal and a second mobile terminal (paragraph 0023)
- b. through Internet Protocol (IP) addressing (paragraph 0213)
- c. in order to access open information stored in the second mobile terminal, the open information being allowed to be accessed from the second mobile terminal (paragraphs 0311, 0321, 0322);
- d. obtaining, from the second mobile terminal, the information item selected by the user of the first mobile terminal to be used in establishing a communication link between the first mobile terminal and a third mobile terminal via a mobile telecommunications network (paragraphs 0311, 0321, 0322),

but does not disclose displaying, on a screen of the first mobile terminal, the open information accessed from the second mobile terminal to allow a user of the first mobile terminal to select at least one information item in the displayed open information.

However, Birkler discloses displaying, on a screen of the first mobile terminal, the open information accessed from the second mobile terminal to allow a user of the first mobile terminal to select at least one information item in the displayed open information (paragraphs 0015, 0022). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add displaying, on a screen of the first mobile terminal, the open information accessed from the second mobile terminal to allow a user of the first mobile terminal to select at least one information item in the displayed open information to Traversat. One could have been

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motivated to add disclose displaying, on a screen of the first mobile terminal, the open information accessed from the second mobile terminal to allow a user of the first mobile terminal to select at least one information item in the displayed open information to Traversat because it is obvious that if a user of a mobile terminal or peer in Traversat is going to establish a connection with a third mobile terminal or peer by obtaining the connection information from a rendezvous peer, the information must be made accessible, i.e. visible) to the user of the first mobile terminal and the user must be able to select which third mobile terminal or peer with which to connect.

Claim 30 (after renumbering): Traversat discloses a mobile terminal system comprising:

- a. communication means configured to establish a connection between a first mobile terminal and a second mobile terminal (paragraph 0023)
- b. via an Interact Protocol (IP) network (paragraph 0213)
- c. to access open information stored in the second mobile terminal, the open information being allowed to be accessed from the second mobile terminal (paragraphs 0311, 0321, 0322);
- d. allowing the user of the first mobile terminal to establish a connection with a mobile telecommunication network to contact a third mobile terminal using the selected information item (paragraphs 0311, 0321, 0322);
- e. wherein the contact to the third mobile terminal can be performed without inquiring a user of the second mobile terminal paragraphs 0311, 0321, 0322);

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but does not disclose

- a. a screen configured to display the open information accessed from the second mobile terminal to allow a user of the first mobile terminal to select at least one information item in the displayed open information,
- b. wherein the communication means and the display cooperate to allow the user of the first mobile terminal to establish a connection with a mobile telecommunication network to contact a third mobile terminal using the selected information item, and

However, Birkler discloses accessing and displaying information stored on a second mobile terminal on the display of a first mobile terminal (paragraphs 0015, 0022).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add

- a. a screen configured to display the open information accessed from the second mobile terminal to allow a user of the first mobile terminal to select at least one information item in the displayed open information,
- b. wherein the communication means and the display cooperate to allow the user of the first mobile terminal to establish a connection with a mobile telecommunication network to contact a third mobile terminal using the selected information item,

to Traversat. one could have been motivated to add



- a. a screen configured to display the open information accessed from the second mobile terminal to allow a user of the first mobile terminal to select at least one information item in the displayed open information,
- b. wherein the communication means and the display cooperate to allow the user of the first mobile terminal to establish a connection with a mobile telecommunication network to contact a third mobile terminal using the selected information item,

because it is obvious that if a user of a mobile terminal or peer in Traversat is going to establish a connection with a third mobile terminal or peer by obtaining the connection information from a rendezvous peer, the information must be made accessible, i.e. visible) to the user of the first mobile terminal and the user must be able to select which third mobile terminal or peer with which to connect.

Claims 24 and 31 (after renumbering): Traversat and Birkler disclose the method and mobile terminal system of claims 23 and 30 (after renumbering) and Traversat further discloses the first and second mobile terminals are connected with an IP network in a peer-to-peer manner (paragraph 0213).

Claims 25 and 32 (after renumbering): Traversat and Birkler disclose the method and mobile terminal system of claims 23 and 30 (after renumbering) and Traversat further discloses for the establishing step, the first mobile terminal requests the second mobile

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terminal to connect with an IP network via the mobile telecommunication network if such connection is currently not established (paragraphs 0023, 0213, 0321).

Claims 26 ad 33 (after renumbering): Traversat and Birkler disclose the method and mobile terminal system of claims 23 and 30 (after renumbering), and Traversat further discloses the information item comprises at least one phone number or other user information (paragraph 0322).

Claims 28 (after renumbering) and 35 (after renumbering): Traversat and Birkler disclose the method and mobile terminal system of claims 23 and 30 (after renumbering), and Traversat further discloses the first and second mobile terminals are cell phones (paragraph 0071).

Claims 29 (after renumbering) and 36 (after renumbering): Traversat and Birkler disclose the method and mobile terminal system of claims 23 and 30 (after renumbering), but does not disclose the mobile communication network is a CDMA (Code Division Multiple Access) network. However, official notice is take that it is old and well known that mobile terminals such as cell phones communicate using Internet Protocol (IP) over CDMA networks, as disclosed in Rosen et al. (US 2002/0173327 A1) paragraph 0024. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add the mobile communication network is a CDMA (Code Division Multiple Access) network to Traversat and Birkler. One could have been

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motivated to add the mobile communication network is a CDMA (Code Division Multiple Access) network to Traversat and Birkler because Traversat discloses that cell phones can act as peers in the disclosed network (paragraph 0071) and that the peer can communicate using IP (paragraph 0213), therefore, it would have been efficient and would have reduced implementation errors to use a known and stable network system.

6. Claims 27 (after renumbering) and 34 (after renumbering) are rejected under 35 U.S.C. 103(a) as being unpatentable over Traversat et al. (US 2002/0184311 A1) in view of Birkler et al. (US 2002/0069298 A1) as applied to claims 23 and 30 (after renumbering) above, and further in view of Park et al. (US 2003/0039241 A1).

Claims 27 (after renumbering) and 34 (after renumbering): Traversat and Birkler disclose the method and mobile terminal system of claims 23 and 30 (after renumbering) and Traversat further discloses the establishing step comprising connecting the first mobile terminal with the second mobile terminal through an IP address of the second mobile terminal obtained (paragraph 0213), wherein a peer can be a data center server (paragraph 0079), but does not disclose:

- a. obtaining an IP address corresponding to a phone number of the second mobile terminal from a Web server; and
- b. connecting the first mobile terminal with the second mobile terminal through the IP address of the second mobile terminal obtained from the Web server.

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However, Park discloses mapping a telephone number to an internet protocol (IP) address (abstract, paragraphs 0043 and 0045) and Traversat discloses that a peer, including a rendezvous peer, can be a data center server (paragraph 0079). A web server is a type of data center server. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add

- a. obtaining an IP address corresponding to a phone number of the second mobile terminal from a Web server to Traversat and Birkler.
- b. connecting the first mobile terminal with the second mobile terminal through the IP address of the second mobile terminal obtained from the Web server,

to Traversat and Birkler . One could have been motivated to add

- a. obtaining an IP address corresponding to a phone number of the second mobile terminal from a Web server to
- b. connecting the first mobile terminal with the second mobile terminal through the IP address of the second mobile terminal obtained from the Web server,

to Traversat and Birkler because Traversat discloses that the peer-to-peer (P2P) platform described therein is, preferably, designed to be independent of transport protocols, however, it may be implemented on top of TCP/IP, HTTP, Bluetooth, HomePNA, and other protocols. Further, Traversat discloses that the system built on

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top of the P2P platform preferably functions in the same or similar fashion when the system is expanded to a new networking environment or to a new class of devices, as long as there is a correct transport protocol handler for the new networking protocol. (paragraph 0063). Furthermore, Traversat discloses that the referenced peer-to-peer (P2P) platform may be implemented on top of TCP/IP, HTTP, Bluetooth, HomePNA, and many other protocols (paragraph 0014). Further Traversat discloses using a universal unique identifier (UUID) and supporting sophisticated naming and binding services (paragraph 0092). Park discloses a personal digital assistant (PDA) (figure 1) used within the context of the invention wherein there is provided a telephone number input section for receiving a telephone number, a domain name conversion section for converting said received telephone number into a domain name and an address request for requesting an Internet protocol (IP) address corresponding to said converted domain name (paragraph 0019) thereby allowing a telephone number to be unique worldwide (paragraph 0018). Further, Park includes a reference to Mizell et al. (US 6,201,965 B1) Telecommunication subscriber connection using a domain name system. Mizell discloses a system and method for completing a data network connection to a data terminal (column 1, lines 6-9), i.e. since Park makes its disclosure in light of the disclosure of Mizell, although Park makes specific mention to voice over internet protocol (VoIP), the limitations of Park may be implemented with respect to data communications as well. Furthermore, Parks mapping of telephone number, domain name and IP address is clearly within the scope of Traversat, given that Traversat may be implemented on top of TCP/IP and Traversat's disclosed need for a UUID and

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Traversat's specific disclosure of naming and binding services. Therefore, it is the opinion that there is ample motivation within both Traversat and Park for the combination of Traversat with Parks mapping of telephone number, domain name and IP address.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. HEFFINGTON whose telephone number is (571)270-1696. The examiner can normally be reached on Mon - Fri 8:00 - 5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Ba Huynh/  
Primary Examiner, Art Unit 2179